

Hearing:  
September 10, 1997

Paper No. 25  
JQ

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

8/12/98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Conopco, Inc.  
v.  
Shangrila, Inc.

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Opposition No. 96,631  
to application Serial No. 74/502,319  
filed on March 21, 1994

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Bruce N. Proctor and Peter M. Mendelson for Conopco, Inc.

Jay H. Geller for Shangrila, Inc.

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Before Hanak, Quinn and Hairston, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Shangrila, Inc. to  
register the mark CERAMIDEA for "[a] complete line of  
nonmedicated skin care preparations."<sup>1</sup>

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<sup>1</sup> Application Serial No. 74/502,319, filed March 21, 1994,  
alleging a bona fide intention to use the mark in commerce. In  
the application applicant indicated that it intended to use the  
mark as a house mark. Applicant also indicated, in an  
Examiner's Amendment, that the term sought to be registered "has  
no known translation, meaning in the field or industry, surname  
or geographic significance."

Registration has been opposed by Conopco, Inc. doing business as Elizabeth Arden Co. The basis for opposition, as set forth in an amended notice of opposition, is that the term sought to be registered, as used in connection with applicant's goods, "is so highly descriptive of Applicant's products that it is incapable of functioning as a trademark." Opposer also goes on to allege that the term CERAMIDEA is merely descriptive under Section 2(e)(1) of the Trademark Act.<sup>2</sup>

Applicant, in its answer to the amended notice of opposition, denied the allegations of genericness and mere descriptiveness.

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<sup>2</sup> Opposer, in its brief on the case, accuses applicant of a "lack of candor before the USPTO." So as to clear on this point, opposer indicated, however, in its reply brief, that it "has not gone so far as to accuse Applicant of fraud before the [Office]." Rather, according to opposer, it has highlighted two instances which "call Applicant's candor and credibility into question." We have considered opposer's remarks in making our decision, but find them lacking in merit. Given the disposition of this case, applicant's response, to the Examining Attorney's inquiry, that CERAMIDEA does not have any significance in the trade appears correct. As to the perceived discrepancy between an interrogatory response and Dr. Lin's testimony regarding the selection of applicant's mark, opposer could have moved to compel when applicant, in its answer to opposer's interrogatory no. 9, did not address specifically "the reasons for selecting [the] mark." If a party which served a discovery request receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. See: TBMP § 523.04; and Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987). Here, opposer did not move to compel when applicant failed to set forth a specific response to that portion of interrogatory no. 9 which requested the reasons for selecting the involved mark.

The record includes the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; applicant's responses to requests for admissions and interrogatories, all introduced by way of opposer's notices of reliance; and opposer's responses to interrogatories made of record in applicant's notice of reliance. Both parties filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

According to John McCook, opposer's vice president for research and development, opposer sells cosmetic products which contain ceramides. Mr. McCook testified that opposer and others in the trade stress the unique benefits of ceramides contained as ingredients in their products.

Applicant took the testimony of its founder and owner, Joseph Lin, who has a Ph.D. in chemical engineering. Dr. Lin selected the term sought to be registered. Literature bearing on applicant's product indicates that "Ceramidea contains natural Ceramides...."

The parties agree, and the record reveals, that ceramides are a class of chemicals which represent a part of the barrier portion of the skin. Mr. McCook testified as follows (dep., pp.8-9):

Ceramides are a class of chemicals which are also generically called sphingolipids. They are molecules that have a particular base, which is either

sphingosine, phytosphingosine or sphingonine, and attached to that base are fatty acids that's the amino group.

These particular classes of materials are found in nature, particularly in mammals and in humans, they represent a significant part of the barrier portion of the skin.

The barrier is contained mainly in the portion of the skin called the stratum corneum. So approximately 45 percent of the barrier materials in the stratum corneum are Ceramides or sphingolipids, which are referred to commonly as Ceramides.

Mr. McCook went on to say that opposer and applicant, as well as others in the industry, use ceramides in their products. Mr. McCook indicated that "Ceramides are extremely important for maintaining the barrier and that indeed you can include Ceramides in products and improve barrier function." (dep., pp. 9-10) He stated that some of opposer's products contain ceramides "to have a beneficial effect on the barrier in the stratum corneum and those benefits are moisturization, smoothing of skin and other effects that are related to improvement in the Ceramide barrier." (dep., p. 10) According to Mr. McCook, opposer has communicated to consumers the benefits of ceramides by means of literature, advertising and the training of beauty consultants who assist in the sale of opposer's products in retail stores.

The issues to be determined in this case are whether applicant's term CERAMIDEA is a generic name of a class of skin care preparations, and, if not, whether the term, as applied to applicant's goods, is merely descriptive of them.

A term is a generic name if it refers to the class or category of goods on or in connection with which it is used. *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. See: Section 14(3) of the Trademark Act; *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, supra. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. In *re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). A finding of genericness must be based on clear evidence of generic use. In *re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). A mark is merely descriptive if, as used in connection with the goods, it describes, that is, immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it

directly conveys information regarding the nature, function, purpose, or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992).

There is no question, based on the record in this case, that "ceramide" is a generic term for a class of chemicals used as an ingredient in skin care preparations, including those of applicant's. Based on the very sparse record in this case, we cannot conclude, however, that it necessarily follows that "ceramide" is a generic or merely descriptive term for the skin care products themselves. That is to say, opposer has not met its burden of establishing, by a preponderance of evidence, that "ceramide" likewise is generic or merely descriptive for skin care preparations. In this connection, we note that opposer denied that the term "ceramide" is incapable of functioning as a trademark for its own cosmetic products that contain ceramides. (see opposer's responses to requests for admissions nos. 19, 20 and 26)

In considering the merits of this case, we acknowledge that the addition, deletion or change in one letter normally does not transform a generic or merely descriptive term into a source indicator. See cases cited at 2 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 11:31 and 12:38 (4th ed. 1998). Here, the difference between

"ceramide" and "Ceramidea" is the addition of only one letter, namely, the last letter "a." However, as we view it, and contrary to opposer's position, CERAMIDEA is neither the equivalent of "ceramide" nor a mere misspelling of "ceramide." We find that the addition of the letter "a" results in a term that is neither generic nor recognizably descriptive for skin care preparations. Rather, the term CERAMIDEA, as applied to skin care preparations, presents a different commercial impression from the one engendered by the generic term "ceramide" as applied to an ingredient of skin care preparations. See: Sperry Rand Corp. v. Sunbeam Corp., 442 F.2d 979, 170 USPQ 37 (CCPA 1971)[While LEKTRONIC may be phonetically close to "electronic," it does not necessarily follow that the mark LEKTRONIC is merely descriptive of electric shavers.]. Applicant's term CERAMIDEA serves only to suggest that its skin care preparations contain as an ingredient ceramides. The record does not establish the extent to which the relevant public is familiar with ceramides and their benefits as ingredients in skin care preparations. Further, the record is completely devoid of any uses in the industry by others of CERAMIDEA in either a generic or descriptive fashion. Simply put, we find that consumers, upon encountering applicant's term CERAMIDEA for skin care preparations, would

be likely to perceive the term as suggestive of an ingredient of the goods.

We are not persuaded by opposer's argument that consumers, if they noticed a change at all, would construe the term CERAMIDEA as the plural form of CERAMIDE. In connection with this argument, opposer relies upon the rules of Latin grammar, citing examples (such as "memorandum" and "memoranda"). Suffice it to say there is nothing in the record to suggest that the term is a Latin (or Greek, as opposer also posits) derived word. Moreover, as applicant is quick to point out, the plural of "ceramide" is "ceramides," an example being opposer's own use of the plural "ceramides" on its labels.

Further, a review of exhibit 11 does not compel a different result in this case. Opposer asserts that applicant has used interchangeably the terms CERAMIDEA and CERAMIDE. Opposer highlights applicant's pamphlet about one of its products, "CERAMIDEA BIO-MOIST TREATMENT," wherein applicant states "THE SECRET OF CERAMIDE BIO-MOIST TREATMENT...." Although at first blush one might characterize this use as "interchangeable," it appears that the use of CERAMIDEA is as a trademark and that the use of CERAMIDE is as a generic adjective. Nonetheless, this one isolated instance is insufficient to support a finding of descriptiveness, let alone of genericness.



The decision here will not give applicant the right to interfere with the fair use (even in a prominent manner) by others, including opposer, of the term "ceramide" alone or in combination with other terms, as in, for example, CERAMIDE TIME COMPLEX MOISTURE CREAM as used by opposer. As Dr. Lin himself testified, applicant does not claim exclusive rights in the term "ceramide" for cosmetic products, and he indicated that applicant does not object to opposer's use of the term "ceramide" in describing an ingredient in opposer's cosmetic products.

In sum, the sparse record, upon which our decision must be based, falls short in proving either genericness or mere descriptiveness.

Decision: The opposition is dismissed.

E. W. Hanak

T. J. Quinn

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board